

## REMARKS

This response is intended as a full and complete response to the Office Action dated September 19, 2007, having a shortened statutory period for response set to expire on December 19, 2007. Please reconsider the claims pending in the application for reasons discussed below.

### Interview Summary

On December 3, 2007, a telephonic interview was held between Gero G. McClellan, Yelena Morozova, and Examiner Nathan Hillery. The parties discussed the cited references including *Wiesehuegel et al.* (U.S. Publication 2002/0128949, hereinafter, "*Wiesehuegel*") and *Keating* (U.S. Publication 2002/0052895, hereinafter, "*Keating*"). Independent claims 1, 11, 24, and 25, and specifically their common elements were discussed.

During the interview, Applicants argued several points. First, *Keating* cannot be used to modify *Wiesehuegel* as suggested by the Examiner because it makes *Wiesehuegel's* system unsatisfactory. Second, the combination of *Wiesehuegel* and *Keating* does teach each and every element of Applicants' independent claims 1, 11, 24, and 25. No agreement could be reached at the time of the interview. While the Examiner agreed with the Applicants that *Wiesehuegel* does not expressly teach the following element: "making the one or more executable functions corresponding to the portion of the user-selectable elements unavailable to the user viewing the re-configured web page without setting values of variables within an underlying application code," the Examiner indicated that the element is inherent from *Wiesehuegel*.

### Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 5, 6, 11-13, 15, 24 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Wiesehuegel* as applied to claims 1 and 11, and further in view of *Keating*.

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and the third criteria.

Regarding the first criteria, the case law is clear that the mere possibility of some combination does not make that combination obvious. Rather, the references must provide some reason why a person of ordinary skill in the art would make the combination/modification as suggested by the Examiner. Further, it is also well established that a *prima facie* case of obviousness cannot be premised on a proposed combination/modification that renders the system unsatisfactory for its intended purpose or changes a principle of operation of the reference relied upon by the Examiner. MPEP § 2143.01.

In this case, the combination/modification suggested by the Examiner simply does not lend itself to the objectives of *Wiesehuegel*, and, consequently, there is no reason to make the combination/modification suggested by the Examiner. Specifically, *Wiesehuegel* is directed to a method and a system allowing traders (promoters of offers) to produce offerings to brokers (bidders) by applying brokers' profiles to a list of available goods/services (see, e.g., paragraphs [0031] - [0034]). The brokers may submit bids in response to the offerings, which subsequently may be accepted by the traders (see, e.g., paragraphs [0034]). The bidding process can be provided via a web browser (see, e.g., paragraphs [0034]).

The Examiner suggests modifying *Wiesehuegel* to use an XSL transform instead of pre-defined transform definition to achieve the predictable result of using a pre-defined XSL transform. Neither in the Office Action, nor during the interview did the Examiner state or identify which element(s) of *Wiesehuegel* the Examiner interprets to be the pre-defined transform definition. While Applicants disagree that *Wiesehuegel* discloses a pre-defined transform definition, Applicants see several *Wiesehuegel*'s elements which the Examiner might have interpreted to be the pre-defined transform: a bidder profile matrix (Fig. 4), an offering database 52 (paragraph [0048]), or a manufacturer or service provider's goods availability list 55 (paragraph [0049]). Respectfully, an inoperable (from a pragmatic perspective) system results from any of the above named possibilities.

*Wiesehuegel* discloses sending a webpage to a broker, where the webpage includes information about the goods that the broker is entitled to and that are available, based on the broker profile (see, e.g., paragraphs [0043], [0049]-[0051] and [0067]). Particularly, depending on the broker's entitlements, bidding action buttons are displayed and accessible, displayed but disabled, or not displayed at all (paragraph [0067]). Such entitlements are initially defined in the broker profile (see, e.g., paragraphs [0044] – [0045] and [0049]), and subsequently, are transferred to the offering database (see paragraphs [0048]-[0052]).

The bidder profile is a matrix (table) having location-category pairs describing the products and respective flags indicating the bidder's entitlement rights (see paragraphs [0044] and [0045], Fig. 4). The manufacturer or service provider's goods availability list 55 is a list of data (see Fig. 3). The offering database 52 is a database. Each of these methods of storing data allows for faster access to the data and requires less memory to store the data than using XML or XSL documents that would contain the same data because of the inherent qualities of these technologies.

*Wiesehuegel*'s system and method are for conducting trade in various industries. Products and services that are traded by *Wiesehuegel*'s system and method are from numerous geographic locations from around the world (see, e.g., paragraph [0013],

[0043]). Further the system and the method are directed towards numerous bidders. Accordingly, the above identified bidder profile, manufacturer or service provider's goods availability list 55, and offering database 52 contain significant volume of data. However, it is inherently important for a trading transaction, such as contemplated by *Wiesehuegel*, to be conducted in a timely manner. It also important to keep costs involving implementing and supporting such a system and a method to a minimum. Therefore, for *Wiesehuegel* to be operable, it is necessary to keep the time that it takes to access/update data to a minimum. To reduced involved costs, it is further necessary to use the storage space efficiently.

However, applying XML/XSL technologies, including using an XSL transform, instead of at least one of the above named bidder profile, manufacturer or service provider's goods availability list 55, and offering database 52, or any combination thereof, means that the time required to access data to generate and display offerings to the bidders will increase. Moreover, the storage space/memory required to store data will increase as well. Considering the scale of operations involved in the trading system disclosed by *Wiesehuegel*, such increases will be significant and cost-prohibitive.

Therefore, a person of ordinary skill in the art simply has no reason to make the proposed combination/modification. In fact, to the contrary, the references teach away from such a combination because of the resulting inefficiencies introduced by such a combination. The proposed modification also renders the system unsatisfactory for its intended purpose because of the resulting inefficiencies. For at least these reasons, Applicants submit that a *prima facie* case of obviousness has not been established.

Regarding the third criteria of establishing a *prima facie* case of obviousness, *Wiesehuegel*, *Keating*, or their combination fails to disclose at least "making the one or more executable functions corresponding to the portion of the user-selectable elements unavailable to the user viewing the re-configured web page without setting values of variables within an underlying application code," as recited in independent claim 1. During a telephonic interview that took place on December 3, 2007, the Examiner

agreed with the Applicants that *Wiesehuegel* does not expressly teach the above named element. However, the Examiner indicated that the element is inherent from *Wiesehuegel*. Applicants respectfully disagree.

*Wiesehuegel* does not explicitly disclose how web pages containing bidders' offerings are generated or any specifics of an underlying code generating such webpage. Particularly, *Wiesehuegel* does not disclose how, in terms of an application code, bidding buttons become disabled. All that *Wiesehuegel* discloses is that a web page is sent to a bidder and how that page might look, e.g., which buttons should be disabled (see paragraphs [0066]-[0067]; Fig. 7).

For example, as known to a one skilled in the art, the buttons can be disabled by defining a function within the underlying application code, where the function, depending on a value of its parameter, either displays, removes, or disables the buttons and/or corresponding to the buttons actions. The parameter needs to be assigned a value depending on, e.g., values in the bidder profile, and then provided to the function. Accordingly, this method involves changing a variable – assigning different values to the function's parameter depending on the values in the bidder profile. This is entirely different from Applicants' independent claim 1, which expressly states that no variables are changed to disable the executable functions. Therefore, because there is at least one method involving changing variables which can be applied to disable the bidding buttons and because *Wiesehuegel* does not expressly teach to the contrary, the above named element of Applicants' claim 1 is not inherent from *Wiesehuegel*.

Accordingly, because *Wiesehuegel* does not disclose this claim element and because the element is not inherent to *Wiesehuegel*, *Wiesehuegel* does not disclose each and every element of the Applicants' invention, thus a *prima facie* case of obviousness has not been established. Therefore, Applicants' independent claim 1 is allowable under 35 U.S.C. § 103.

Claims 2, 3, 5, and 6 depend from claim 1 and, thus, are allowable at least for the reasons given above. With respect to claims 11, 24, 25, and the claims that depend

therefrom, the claims contain subject matter similar to claim 1. Therefore, the rejection of these claims is also believed to be overcome for at least the reasons provided above.

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

Applicant believes that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. McClellan, Reg. No. 44,227/

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